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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 21

Serial Number: 07/411576

Filing Date: 09/22/89

Appellant(s): Anthony Maglica

IV.

Robert C. Weiss
For Appellant

AUG 17 1992

GROUP 290

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 05/18/92. The Board's attention is directed to copending application 07/410965 (appeal #92-1511) which contains similar issues.

(1) *Status of claims.*

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The statement of the status of claims contained in the brief is correct.

AUG 21 1992

(2) *Status of Amendments After Final.*

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The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is deficient in part because only a concise explanation of the claim is required under 37 C.F.R. § 1.192(c). The claimed design in the present application is directed to a flashlight. Information regarding the commercial

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success of the design is not appropriate nor relevant under this heading.

(4) *Issues.*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Appellant's first issue, whether the profile of the flashlight head shown in the present drawings is the same as the profile of the head of the flashlight head shown in Figs. 2, 3 and 8 of the originally filed drawing is substantially correct, however, all of the figure views must be compared and considered to properly determine whether or not benefit of priority should be granted.

Appellant's sub-issue, whether the examiner's "subjective opinion" can overcome the testimony submitted regarding the appearance of the flashlight, is incorrect. On the contrary, the examiner has carefully considered the testimony, but is not convinced that the flashlight designs are the same in the parent utility applications and the present design application because visually, they are different.

Appellant's second issue is correct.

(5) *Grouping of claims.*

Since only one claim exists in design patent applications, the grouping of claims is not applicable.

(6) *Claims appealed.*

The ornamental design for a miniature flashlight as shown and described.

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(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of the claim under appeal.

4,658,336	Maglica	04/14/87
4,750,095	Huang	06/07/88

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

The claim is rejected under 35 U.S.C. § 103 as being unpatentable over Maglica #4,658,336 in view of Huang.

Although the invention is not identically disclosed or described as set forth in Section 102 of the statute, if the differences between the subject matter sought to be patented, and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary ability in the art to which said subject matter pertains, the invention is not patentable.

The Maglica patent, Fig.8, shows a flashlight of essentially the same appearance as the claimed design except for the rounded head. The Huang patent shows a rounded head similar to that of the claimed design.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Maglica, Fig.8, flashlight by providing a rounded head as

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shown by the Huang flashlight to meet the overall appearance of the claimed design.

This modification of the basic reference in light of the secondary prior art is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. *In re Rosen*, 213 USPQ 347 (CCPA 1982); *In re Carter*, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that one skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. *In re Antle*, 170 USPQ 285 (CCPA 1961) and *In re Nalbandian*, 211 USPQ 782 (CCPA 1982).

The claim is rejected under 35 U.S.C. § 111 for new matter. The proposed additional or amended illustration has been entered, however said amendment introduces new matter (35 U.S.C. § 132, 37 C.F.R. § 1.118). Due to the differences between the original and new drawings, appellant's disclosure fails to comply with the description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the claim is rejected. (*In re Kaslow*, 217 USPQ 1089 and *In re Rasmussen*, 211 USPQ 323.) The new matter is described as follows:

- a) In the new drawing, the candle end of the flashlight is different than the candle end of the original drawing. The new drawing (1/7/92) shows a partially uncovered light. The original drawing shows a completely covered light. Note A Fig.1 on the new drawing and Figs. 1 (formal) and 8 (informal) on the original drawings.
- b) The new drawing shows a significant proportional difference in the candle end - a wider and taller threaded end and a smaller flat top disc. Note B Figs. 1, 2, 3 on the new drawing and Fig.

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8 on the original drawings.

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

Rejection under 35 U.S.C. § 103:

Appellant asserts that since there is "adequate support for the present claimed design" in the original drawings of parent utility application 07/648,032, the benefit of priority should be granted. Consequently, if this priority is granted, the references relied upon would not constitute prior art, and the rejection under 35 U.S.C. § 103 would be overcome.

It remains the examiner's position that he claimed design of the instant application cannot be granted the benefit or priority of parent utility applications 07/356361, 07/222378, 07/034918, 06/828729, 06/648032 because the shape of the flashlight head is not the same in all the cases. In light of this denial of the benefit of priority, the references relied upon in the rejection under 35 U.S.C. § 103 are appropriate prior art.

Appellant asserts that the examiner has solely relied on a "subjective opinion" that the head shapes are different, has provided no basis for determining the head shape difference, and has solely relied on the disclosure of the Fig. 1 view of the parent applications in denying the benefit of priority.

Appellant asserts that submitted testimony by Fred McAlister (engineer), Robert Weiss (attorney for appellant), and Anthony Maglica (inventor) serve as evidence that the

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flashlight heads of the instant application and the parent case are similar. Appellant also asserts that reliance on Figs. 2, 3 and 8 of the parent application supports the curved rounded head shown in the instant application.

In response to appellant's assertions regarding the unsubstantiated determination to deny the benefit of priority, the examiner wishes to clearly state that the difference in the flashlight head shape has been described in office actions (paper #6 mailed 11/13/90 and paper #12 mailed 7/18/91) by written descriptions and photoprints which specifically point out that the claimed design of the instant application shows a flashlight with a rounded head while the drawings of the parent utility application show a distinct change in plane on the flashlight head. In no instance had the examiner based the decision to deny the benefit of priority on the single Fig. 1 view. The examiner has, contrary to appellant's belief, considered all the figure views shown in the parent cases in determining the design of the flashlight. Specifically, Figs. 1-3 of the parent applications show a flashlight head with a distinct change in plane. A planar surface meets another planar surface at a distinct intersection on the surface of the flashlight head. Fig. 8 shows a cut-away view which makes the profile of the head undiscernible. In this case, reliance on the other views is necessary for a clear disclosure and appropriate since Fig. 8 is a direct embodiment of the original embodiment. The examiner does not see the suggestion of the curved, rounded head, with no distinct change in plane, in the figure views of the parent cases; instead, the views support a flashlight head with a distinct intersection. (Note C on the attached photoprint of

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the original informal drawings which shows the intersection of the lines along the side contour. Note D (original formal and the new drawings) which shows intersecting lines, the side contour of the parent utility application flashlight design is not the same as the rounded contour of the flashlight head shape in the new drawings.) In this case, the Fig.2 and 3 cross-sectional views, the Fig.8 perspective view are clarified and reinforced by the Fig.1 perspective view. A direct visual comparison of the claimed design of the instant application with the figure views of the parent applications show that the head shapes are different. It is apparent that there is a straightforward disagreement between the examiner and the appellant as to the visual shape of the flashlight head of the parent application.

The declarations submitted by the appellant have been carefully considered, but do not convince the examiner that the shapes are similar. The inventor testifies that the Fig.1 view in the parent case was a mistake, but this cannot change or excuse what was originally filed in the parent application. The examiner may base a decision only on the original drawings of the parent application as compared to the original drawings of the claimed design of the instant application and cannot dismiss a figure view merely because the appellant asserts that the drawing was a mistake. This type of practice would erode the substance of the laws and regulations of design examination and patents. In any case, since all of the figure views in the parent case are consistent in that they show a flashlight head with a distinct change in plane, the mistake is not evident to the examiner. Again, the examiner is not solely relying on the Fig.1 view.

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The declaration by Robert Weiss describes the submitted drawings of the appellant's course of action, including a description of how the drawings were corrected. Although the attorney believes that the correction of the shape of the head satisfies a proper granting of the benefit of priority, the examiner maintains that the shape of the flashlight head is not the same between the parent cases and the design of the instant application. The examiner also notes that the interview to which the attorney refers in paragraph 11 of the declaration was fairly granted and the decision to conclude the interview occurred when the attorney requested that a judgment on the merits of the case be rendered immediately, in his presence.

The description of the technical data discussed by Fred McAlister is also not convincing. The examiner does not doubt that a process of hand plotting points into computer aided drafting equipment was used in creating the new sets of drawings. However, the examiner wishes to emphasize that the points were hand plotted from an enlargement of a copy of the originally submitted drawing. It is feasible to assume that an enlargement of a drawing may widen and distort the contour line and give adequate room for unintentional adjustments in the plotted points, which may significantly affect the final product. In light of this explanation, and the belief that the appearances are visually different, the examiner maintains that the head in the newest set of submitted drawings (1/7/92) is not similar to the head shape of the parent applications. Regardless of the process utilized in creating the new figures, the examiner has only and may only consider the submitted drawings of the instant application and the original parent drawings when making a determination of priority.

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Written declarations and technical data cannot prove nor disprove what visually occurs on paper. Again, the examiner relies on a direct comparison between the appearances of the figure views of the each case in question.

Apparently, appellant cites Racing Strollers, Inc. v. TRI Industries, 11 USPQ 2d 1300 (CAFC 1989) to show that priority may be based on any illustration of the parent application. The examiner does not dispute this assertion, but is unclear as to how this specific case relates to this assertion. Racing Strollers established that a design patent application is not precluded from gaining benefit of priority from a parent utility application as long as the requirements under 35 U.S.C. § 120 are met. The passage quoted by applicant requires that the claimed design be fully and clearly disclosed in a parent application. A clear understanding of the nature of the specific design can be based on whatever views are necessary to fully and clearly disclose the design. Again, the Figs. 1, 2, 3, 8 of the parent cases clarify the nature of the flashlight head design. Appellant may not rely on nor restrict the nature of an article to only a select number of figure views and through implication, assume that which is not shown, especially when other views are present which clarify the nature of the article.

Appellant cites Ex parte Asano 201 USPQ 315 (1979) to show that minor inconsistencies and mechanical errors cannot sufficiently support a rejection under 35 U.S.C. § 112 if those inconsistencies do not preclude an understanding of the overall nature of the claimed design. The examiner understands the ruling of the Asano case, but disagrees with

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appellant's contention that the difference in the flashlight head shapes is due to a mechanical error or a minor inconsistency similar to that in Asano. In Asano, the numerous minor inconsistencies of the toy vehicle did not affect the overall understanding of the nature of the claimed design. In design patent examining, especially, the rules which describe the standard for a full, complete, consistent disclosure must be applied on a case by case basis because the importance of modifications in the design of articles of manufacture depends wholly on the specific article in question. In this case, the change of the shape of the head is a significant characteristic in light of the many flashlight designs available. A change which may appear slight, relative to other articles of manufacture, may actually be a major, distinguishing change, as is the case here, in view of the flashlight art. Since most flashlights generally have a cylindrical body which holds batteries and a shorter, cylindrical head which holds a bulb, specific characteristics will differentiate one design from another. The understanding that a flashlight head shape is critical to the nature of the flashlight as a whole is manifested in appellant's own reluctance to correct the drawings as described by the examiner (which would ensure the benefit of priority) - the addition of a contour line and shading describing this distinct change in plane on the head.

Appellant directs the Board's attention to the enclosed transparencies of the enlarged figure views in question. The examiner has compared the transparencies and is still not convinced that the shape of the flashlight heads are the same. Though the change to the contour line may appear to be slight, it is significant since it changes the overall appearance

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of the claimed design. Again, the flashlight of the instant application shows a rounded, curved head and the flashlight of the parent application shows a head with a distinct change in plane. The examiner also wishes to note that the simple step of enlarging a drawing can easily distort actual proportions.

Rejection under 35 U.S.C. § 112 ¶ 1 for new matter:

The rejection under 35 U.S.C. ¶ 1 for new matter is based on two differences which remain uncorrected in the drawing disclosure. The examiner believes the differences were made clear in the Final Rejection of 7/18/91 through written description in the office action and the inclusion of photoprints which pointed out the areas in question. Additional descriptions of the inconsistencies have been added to the paragraph a) below in an attempt to further clarify the difference, although it remains the examiner's belief that the difference was obvious from the photoprint. A single comparison between the newly submitted drawings of 1/7/92 and the original drawings will make these differences evident:

a) In the new drawing, the candle end of the flashlight is different than the candle end of the original drawing. The new drawing (1/7/92) shows a partially uncovered light. The original drawing shows a completely covered light. The new drawing shows the cylindrically shaped light coming out from the circular disc. The original drawing shows the cylindrically shaped light resting on the top of the flat top. Note the difference in the photoprints. (A)

b) The new drawing shows a significant proportional difference in the candle end - a wider and taller threaded end and a smaller flat top disc. The proportions are clearly marked on the attached photoprints. (B)

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These differences are not considered slight nor inconsequential because in design applications, the consistency, clarity and accuracy of the drawings are crucial since the drawing is the claim. Again, in design patent examining, the rules which describe a standard of full, complete, consistent disclosure must be applied on a case by case basis because the importance of modifications in the design of articles of manufacture depends wholly on the specific article in question. In this case, the light on the candle end and the proportion of the threaded end is significant in view of the many flashlight designs available. A change which may appear slight, relative to other articles of manufacture, may actually be a major, distinguishing change, as is the case here, in view of the flashlight art.

Specifically, there is no basis for the changes appellant has made in the new drawings. There is no support in the original drawings for the change in the small light on the candle end, nor is there support for the newly proportioned threaded end. These differences cannot simply be dismissed as minor inconsistencies. In view of the significance of these characteristics and the lack of bases for them in the original views, the rejection under 35 U.S.C. § 112 ¶1 maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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August 13, 1992

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GROUP ART UNIT 291

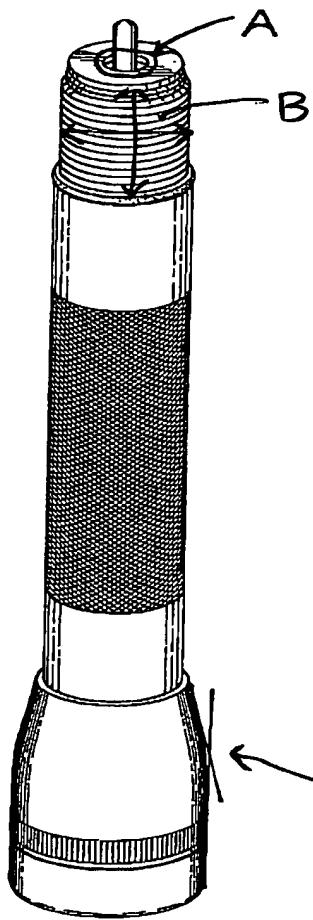


FIG. 1.

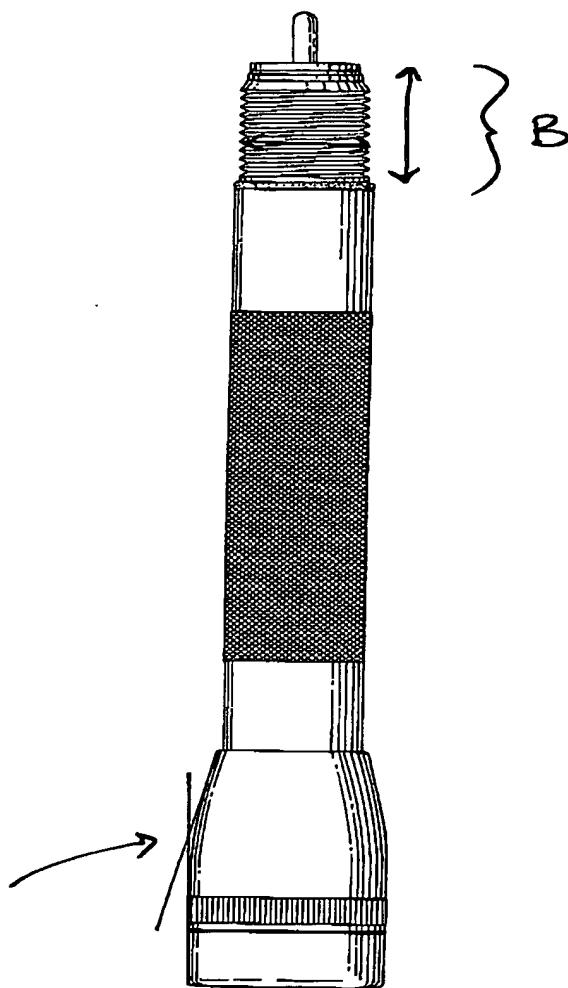


FIG. 2.

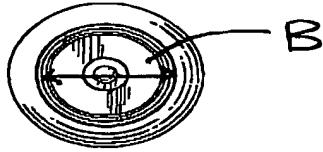


FIG. 3.

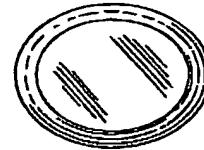


FIG. 4.

copy of 1/7/92 drawings

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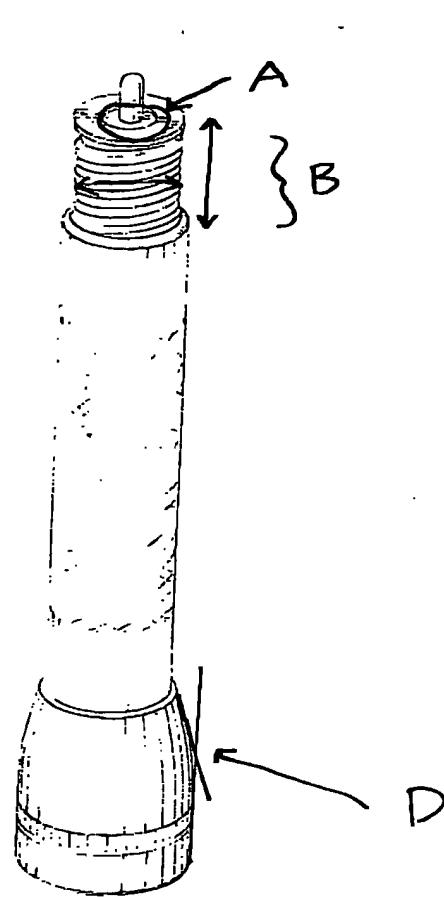


FIG. 1.

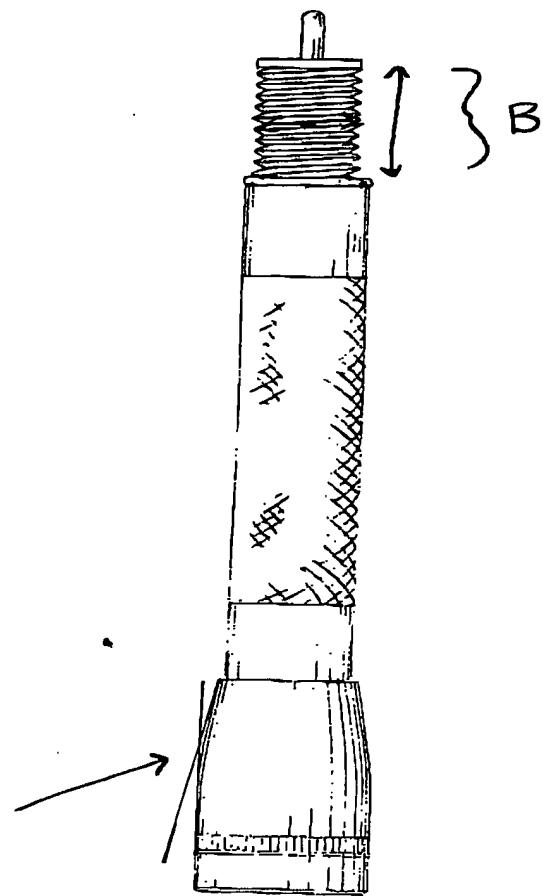


FIG. 2.

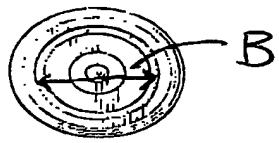


FIG. 3.

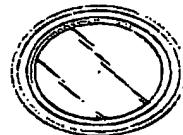


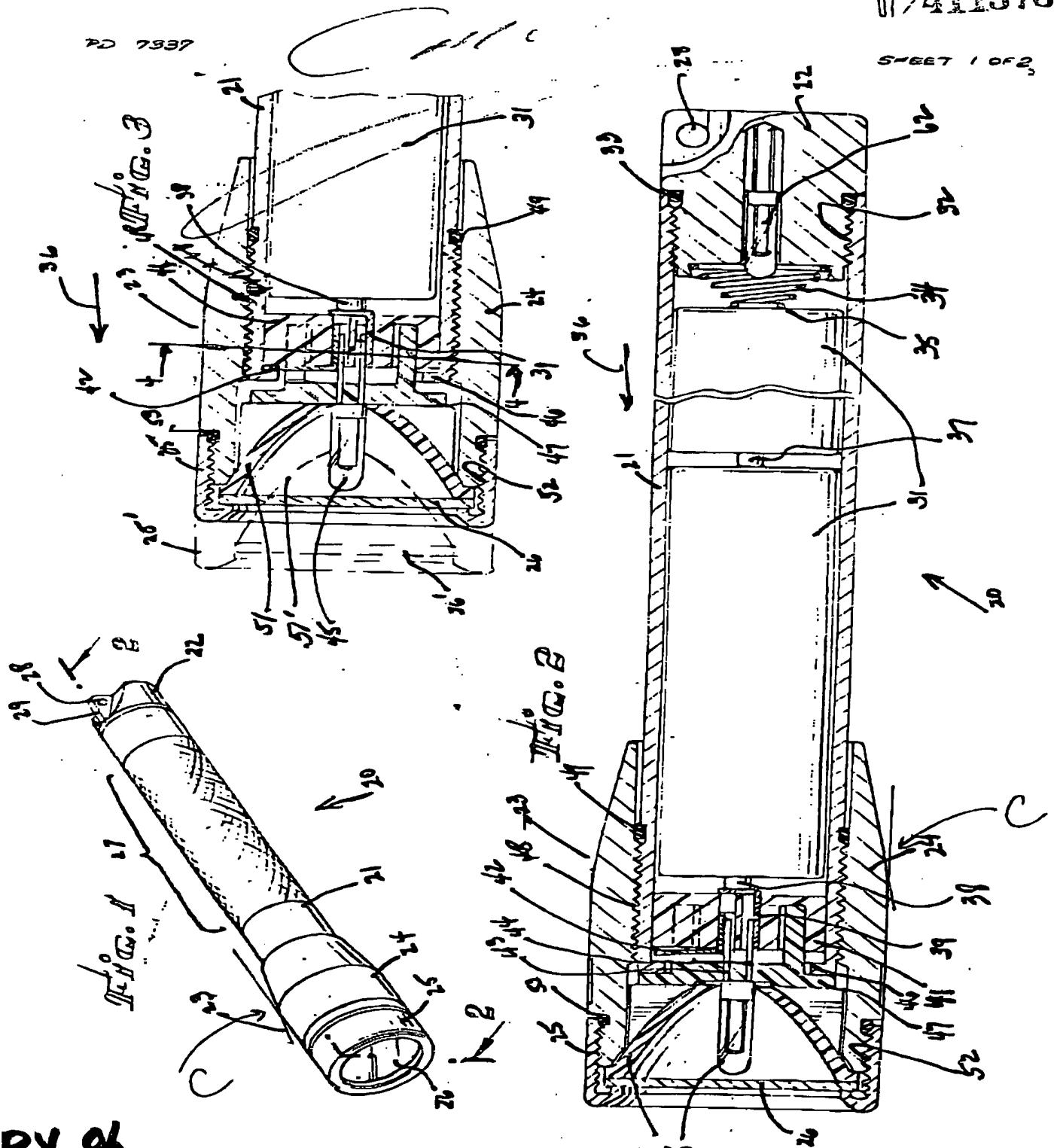
FIG. 4.

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APPLIANT

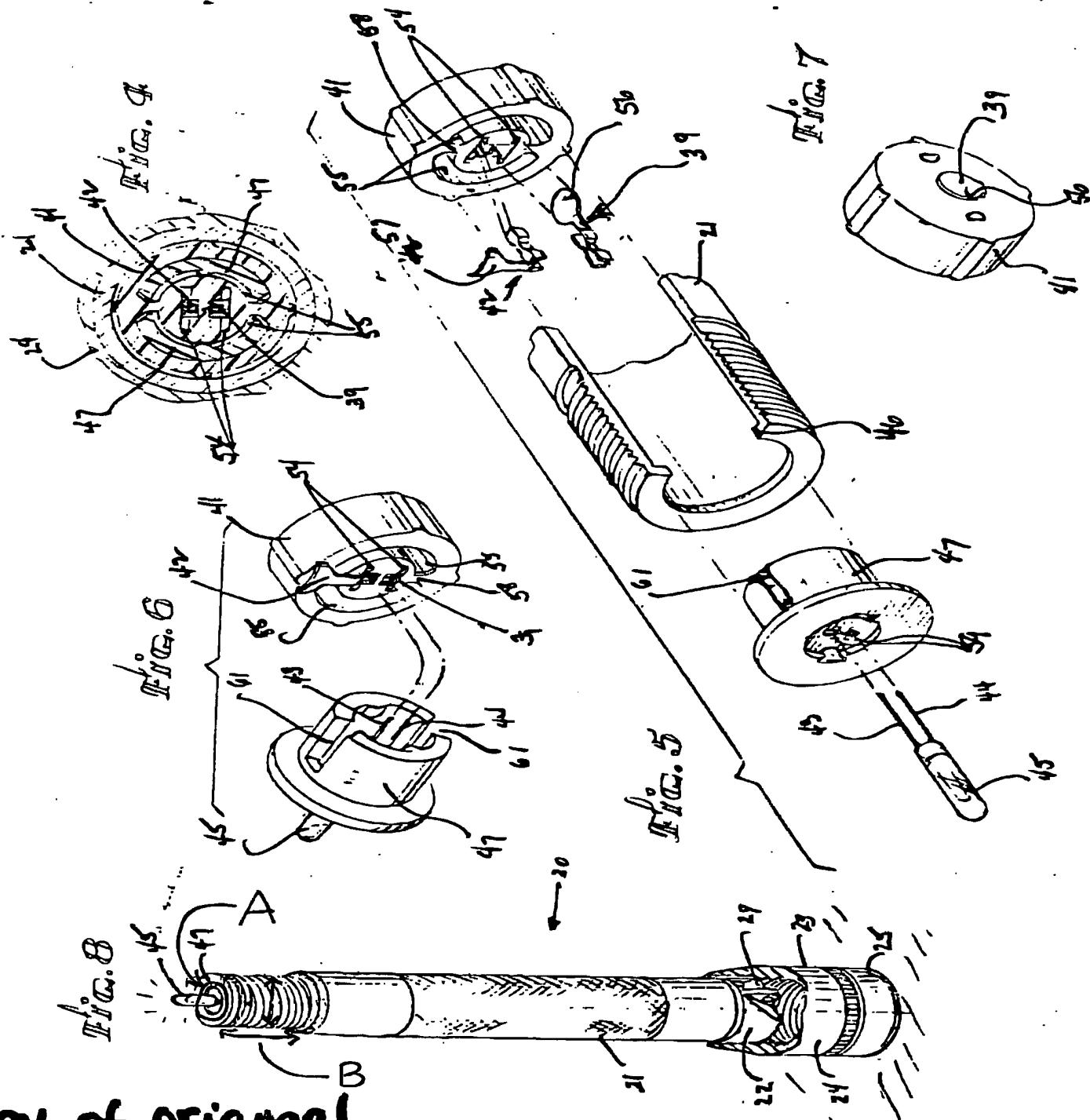


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Notes/Comments:

Pursuant to your request, I am faxing you herewith a copy of the Examiner's Answer of August 17, 1992 in the above-identified case. As I mentioned in my voicemail message, the attachments include color components. As a result, I would like to make arrangements to have a copy of the Examiner's Answer hand delivered to you.

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